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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,932	10/30/2003	James F. McGuckin JR.	1255	1044
7590	04/08/2008		EXAMINER	
NEIL D. GERSHON			SHAFFER, RICHARD R	
REX MEDICAL				
1011 HIGH RIDGE RD			ART UNIT	PAPER NUMBER
Stamford, CT 06905			3733	
			MAIL DATE	DELIVERY MODE
			04/08/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/696,932	MCGUCKIN ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Richard Shaffer	3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 14 February 2008.

2a) This action is **FINAL**.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 2-9, 11, 13-18, 21 and 22 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 2-9, 11, 13-18, 21 and 22 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 14 February 2008 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 3/3/2008.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 14<sup>th</sup>, 2008 has been entered.

### ***Drawings***

The amended drawing sheet for Figures 4 and 5 filed on February 14<sup>th</sup>, 2008 is acknowledged.

The amended drawing sheet is objected to because applicant has modified a previously objected Figure sheet. Applicant in the reply filed on December 18<sup>th</sup>, 2006 had submitted replacement sheets with clean versions of the drawings. It is these sheets that applicant should again modify the sheet containing Figures 4 and 5 should it be desired.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet,

and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action.

***Claim Rejections - 35 USC § 112***

The amendments to the claims filed on February 14th, 2008 are acknowledged and accepted by the examiner. The previous 35 U.S.C. 112, first paragraph rejections are hereby withdrawn.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 18 recites, "**providing a vessel filter having a longitudinal axis having a center point, a mounting section, first and second filtering sections each terminating in a converging end region into a respective first and second tubular portion and a plurality of struts** extending substantially parallel to the longitudinal axis to engage a vessel wall and curving inwardly **and including a portion extending linearly**

**and radially and axially inwardly to the respective filtering section;**" The text is bold where there is indefinite language. How can a filter having a mounting section and a filtering section and a plurality of struts when the struts are what define both sections? Further, it is not clear how the struts extend linearly, radially and axially inward when examining Figure 5, it is clear that the direction of inward movement is only along two axes. Claim 21 is what appears to be what applicant meant, that a linear portion extends axially and radially inward.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

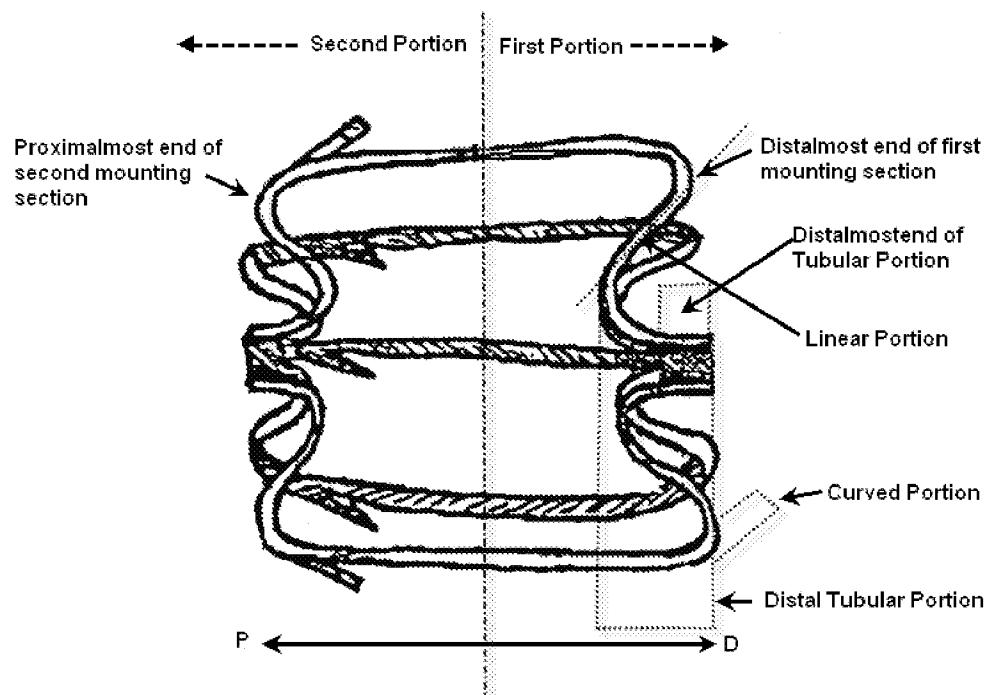
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-7, 9, 11, 13, 14, 16, 18, 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bosma et al (US Patent 6,443,972) in view of van der Burg et al (US Patent 6,994,092).

Bosma et al disclose a vessel filter (**Figures 5 and 8-9C**) and method (**Figure 1**) comprising: a mounting section (middle section) having a proximal and distal end; two filtering sections (angled portions converging at tubular sections); the filtering sections defined by a plurality of longitudinal struts with ribs connecting adjacent struts; the device is self-expanding Nitinol (**Column 4, Lines 11-15**); the struts are spaced circumferentially about 60 degrees apart; a plurality of vessel engaging members (**27**) and/or roughening (**Column 6, Lines 52-53**); and the struts (in **Figure 8**) have an

angled portion with a width less than the width of the straight portion of the mounting section.

Bosma et al disclose all of the claimed limitations except for the specific structure and location of the filtering section with regard to the mounting section. van der Burg et al teach (**Figure 35; Column 18, Lines 34-55**) that an expandable device for placement against a bodily tubular structure with an S-shape end portion provides an elongated mounting section which improves contact area. It would have been obvious to one having ordinary skill in the art at the time of invention to design the filter of Bosma et al according to the structure taught in van der Burg et al in order to improve fixation within the blood vessel. In regard to applicant's extensive claim language defining the relationship between the filter section and mounting section, see the Figure below depicting how the structure of van der Burg et al meets the claimed limitations.



Claims 8, 15, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bosma in view of van der Burg et al and in further view of Gilson et al (US Patent Application Publication 2002/0058911).

The combination of Bosma and van der Burg et al disclose and teach all of the claimed limitations except for struts out of phase. Gilson et al teach in **Figures 15-22** out of phase struts as an appropriate structure for forming an expandable structure to act as an embolic filter. It would have been obvious to one having ordinary skill in the art at the time the invention was made to design the combination of Bosma and van der Burg et al with out of phase struts as a matter of mere substitution for providing an expandable embolic filter with predictable results.

### ***Response to Arguments***

Applicant's arguments filed March 3<sup>rd</sup>, 2008 have been fully considered but they are not persuasive. In particular, a new interpretation of the device of van der Burg et al has been conducted due to the new independent claims. Specifically, it is shown how the structure disclosures a linear portion longer than a curved portion as well as the distalmost end of the distal tubular section is proximal to the distalmost end of the distal mounting section.

Further, the combination of Bosma et al and van der Burg et al is deemed proper due to the analogous means of providing for a stable structure within a blood vessel as described in the previous Office Action and reiterated in the current Office Action.

***Conclusion***

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard Shaffer whose telephone number is (571)272-8683. The examiner can normally be reached on Monday-Friday (7am-5pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Richard Shaffer/  
Examiner, Art Unit 3733

/Eduardo C. Robert/  
Supervisory Patent Examiner, Art Unit 3733